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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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03/03/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary	Application No. 10/550,132	Applicant(s) NONOMURA ET AL.	
	Examiner TAMRA L. DICUS	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-14 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

All prior rejections are withdrawn.

Election/Restrictions

Applicant's election of group I without traverse in the reply filed 12/05/08 is acknowledged.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-12 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Doelle et al. (WO 03/072875 -US PGPUB 2005/0121157 a1).

It is noted that when utilizing WO03/072875 in the above paragraph, the disclosures of the reference are based on US PGPUB 2005/0121157 which is an English language equivalent of the reference. Therefore, the column and line numbers cited with respect to WO 03/072875 are found in US PGPUB 2005/0121157.

Doelle teaches a papermaking newsprint wherein it is well known to have typically included filler and paper, 5 to 20% ash content, where precipitated calcium carbonate is selected to improve the appearance of paper (falls in

Art Unit: 1794

Applicant's recited ranges) and exact grain size range. See [0019, 0021, 0026-0031].

The paper of Doelle is made from pressed newsprint paper, which is still paper nonetheless because it is of pressed paper fibers. Without such reliance, however, a preamble is generally not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention. Consequently, "preamble language merely extolling benefits or features of the claimed invention does not limit the claim scope without clear reliance on those benefits or features as patentably significant." In *Poly-America LP v. GSE Lining Tech. Inc.*, 383 F.3d 1303, 1310, 72 USPQ2d 1685, 1689 (Fed. Cir. 2004). How the calcium carbonate is produced (i.e. by a chemical method) carries little weight because it is a process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. In *re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. In *re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Applicant's attention is directed to the following regarding all properties (i.e. zeta potential) and function : It is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." *In re Swinehart et al.*, 169 USPQ 226 at 229. Since the references teach all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. Recitation of a newly disclosed property does not distinguish over a reference disclosure of the article or composition claims. *General Electric v. Jewe Incandescent Lamp Co.*, 67 USPQ 155. *Titanium Metal Corp. v. Banner*, 227 USPQ 773. Applicant bears responsibility for proving that reference composition does not possess the characteristics recited in the claims. *In re Fritzgerald*, 205 USPQ 597, *In re Best*, 195 USPQ 430.

Claims 6-12 and 20 are met.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doelle et al. (WO 03/072875 -US PGPUB 2005/0121157 a1).in view of Hirabayashi et al. (US 6,458,413).

Doelle essentially teaches the claimed invention above.

Doelle doesn't teach a clear coat or deinked pulp (claims 13—14), while generally teaching dry paper.

Hirabayashi teaches dry paper sludge such as deinked pulp used as paper pulp in web-offset printing for coated paper (12:15-35) wherein the coat is from known polyvinyl alcohol (PVA), the same ingredient Applicant admits yields the clear coat described on page 4, last paragraph of the instant specification, which heightens the inner bond strength and adds blister resistance to the surface of paper for web-offset printing (11:35-68). See also 3:35-68, 4:15-50.

Thus it would have been obvious to one having ordinary skill in the art to modify the paper of Doelle to include a clear coat and deinked pulp because Hirabayashi teaches the additions help to heighten the inner bond strength and adds blister resistance to the surface of paper for web-offset printing as cited above.

Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doelle et al. (WO 03/072875 -US PGPUB 2005/0121157 a1).in view of Hirabayashi et al. (US 6,458,413) and Maruyama et al. (US 5,527852).

Doelle teaches the claimed invention above.

Doelle doesn't teach a clear coat or deinked pulp (claims 13—14), while generally teaching dry paper.

Hirabayashi teaches dry paper sludge specifically including deinked pulp used as paper pulp in web-offset printing for coated paper (12:15-35) wherein the coat is comprised of known polyvinyl alcohol (PVA), which heightens the inner bond strength and adds blister resistance to the surface of paper for web-offset printing (11:35-68). See also 3:35-68, 4:15-50.

Hirabayashi doesn't teach the PVA is clear.

Maruyama teaches PVA is a clear coating agent known to improve the surface characteristics of paper, such as smoothness, luster, and barrier properties. See 1:10-20, 2:50-68, Example 1.

Thus it would have been obvious to one having ordinary skill in the art to modify the paper of Doelle to include a clear coat and deinked pulp because Hirabayashi teaches the additions help to heighten the inner bond strength and adds blister resistance to the surface of paper for web-offset printing as cited above and Maruyama teaches PVA is a clear coat known to improve surface characteristics of paper, such as smoothness, luster, and barrier properties as cited above.

Response to Arguments

Applicant's arguments filed have been fully considered and are persuasive, thus a new grounds of rejection is presented above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tamra L. Dicus /TLD/
Examiner
Art Unit 1794

Feb 24. 2009